

Stavrianopoulos et al., U.S. Pat. Appl. Ser. No. 08/486,070 (Filed June 7, 1995)  
Page 41 [Amendment Under 37 C.F.R. §1.116 (In Response To The  
September 29, 2005 Office Action) -- November 2, 2005]

**REMARKS**

Reconsideration of this application is respectfully requested.

After entry of the complete listing of the claims provided above, the status  
of the claims is as follows:

<b><u>Claims previously pending:</u></b>	Claims 3144-3147, 3150-3155, 3157-3169, 3172-3175, 3179-3183, 3185-3201, 3204-3209, 3211-3224, 3227-3232, 3234-3238, 3240-3248, 3252-3256, 3258-3268, 3271-3277, 3279-3283 and 3287-3407.
<b><u>Claims currently amended:</u></b>	Claims 3147, 3175, 3201, 3248, 3258 and 3275- 3276.
<b><u>Claims currently canceled:</u></b>	None.
<b><u>Claims previously canceled:</u></b>	Claims 1-3143, 3148-3149, 3156, 3170-3171, 3176-3178, 3184, 3202-3203, 3210, 3225- 3226, 3233, 3239, 3249-3251, 3257, 3269- 3270, 3278 and 3284-3286.
<b><u>Claims currently added:</u></b>	None.
<b><u>Claims presently presented:</u></b>	Claims 3144-3147, 3150-3155, 3157-3169, 3172-3175, 3179-3183, 3185-3201, 3204-3209, 3211-3224, 3227-3232, 3234-3238, 3240-3248, 3252-3256, 3258-3268, 3271-3277, 3279-3283 and 3287-3407.

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Entry of the above claim listing and claim amendments is respectfully requested.

Applicants are grateful to Primary Examiner John S. Brusca, Group Art Unit 1631, for the time and courtesy which he extended to Applicants' undersigned attorney and their two legal representatives, Eugene C. Rzucidlo, Esq. and Robert M. Schulman, Esq. during the interview held at the U.S. Patent Office on October 28, 2005.

**I. Summary of October 28, 2005 Interview**

At the interview it was agreed to drop the anticipation rejection (35 U.S.C. §102(e)2) because Stuart et al. (U.S. Patent No. 4,732,847) does not show arrays or labeled polynucleotides on a (non-porous) substrate (solid support), as set forth in the pending claims.

At the interview it was also agreed to drop in part the new matter rejection (35 U.S.C. §112, first paragraph) because the specification provides support for various (different) polynucleotides (nucleic acids) on a solid (non-porous) substrate (solid support).

At the interview Applicants stated their intention to file an amendment after final to address rejections under 35 U.S.C. §112, first and second paragraphs, regarding the terms "beads" and "indirectly fixed or immobilized."

The interview was then concluded.

**II. Claim Amendments**

As set forth in the claim listing above, seven claims (3147, 3175, 3201, 3248, 3258, 3275 and 3276) in this application have been amended.

First, in four of these claims (3147, 3175, 3201 and 3248), Applicants have deleted the phrase "a bead or beads" from the recited elements for the non-porous solid support. The deletion of these terms obviates part of the new matter

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rejection (see September 29, 2005 Office Action, page 3, second paragraph). As is well established under 35 U.S.C. §112, para. 1, a specification may contain a written description of a broadly claimed invention without describing all species. Utter v. Hiraga, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988). Furthermore, an applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention. A specification may, within the meaning of 35 U.S.C. §112, para. 1, contain a written description of a broadly claimed invention without describing all species that the claim encompasses. Cordis Corp. v. Medtronic AVE Inc., 67 USPQ2d 1876, 1886 (Fed. Cir. 2003). Accordingly, it should be apparent that even though Applicants are deleting reference to one particular species in four dependent claims, nevertheless, the genus of non-porous solid supports finds full support and it clearly encompasses such deleted species regardless of whether such species finds literal support under 35 U.S.C. §112, para. 1.

In claim 3258, a single word ("Indirectly") has been removed. Finally, in claims 3275 and 3276, the *in situ* language has been re-stated to remove the "indirect" fixation or immobilization. Thus, both claims now recite at their end "wherein said fixation or immobilization is not to a cell fixed *in situ* to said non-porous solid support."

The above amendments raise no new issues, nor do any of the amendments require further consideration and/or search. Furthermore, the above claim amendments do not raise any issue of new matter. In view of the agreement reached during the October 28, 2005 interview, Applicants respectfully maintain that the amendments place the application in condition for allowance, and are, therefore, properly entered. At the very least, the amendments place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

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Before addressing the rejections, Applicants acknowledge the indication in the September 29, 2005 Office Action that rejections and/or objections not reiterated from previous office actions are hereby withdrawn. These include certain other rejections for new matter (35 U.S.C. §112, 1st ¶) and vagueness and indefiniteness (35 U.S.C. §112, 2nd ¶).

### **III. The Rejections in the September 29, 2005 Office Action**

#### **A. The Rejection Under 35 U.S.C. §112, First Paragraph**

Claims 3147, 3175, 3198-3201, 3204-3209, 3211-3221, 3248, 3302-3309, 3326-3327 and 3362-3379 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The text of the written description rejection is set forth on pages 3-7 in the September 29, 2005 Office Action.

With respect to the new matter rejection for "a bead or beads," the amendments to claims 3147, 3175, 3201 and 3248 obviates the rejection.

With respect to a generic "array" comprising "various" nucleic acids, it was agreed at the October 28, 2005 interview that the specification provides support for various (different) polynucleotide samples on a solid substrate.

Thus, both grounds of new matter are believed to have been overcome by amendment or agreement. Reconsideration and withdrawal of the new matter rejection is respectfully requested.

#### **B. The Rejection Under 35 U.S.C. §112, Second Paragraph**

Claims 3258, 3275-3277 and 3292-3293 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The text of the indefiniteness rejection is set forth on page 8 in the Office Action.

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As indicated in both the claim listing and opening remarks above, claims 3258 and 3275-3276 have been amended to remove language directed to "indirect" fixation or immobilization. In view of those amendments, the rejection under §112, second paragraph, is believed to have been overcome.

Reconsideration and withdrawal of the indefiniteness rejection is respectfully requested.

**C. The Anticipation Rejection Under 35 U.S.C. §102(e)(2)**

Claims 3300-3302, 3306, 3308, 3362, 3366-3370, 3373 and 3376-3378 stand rejected under 35 U.S.C. §102(e)(2) as being anticipated by Stuart et al., U.S. Patent No. 4,732,847. The text of the anticipation rejection is given on pages 8-9 in the Office Action.

At the interview, it was agreed to drop the rejection under §102(e) over Stuart et al. because it does not show arrays or labeled polynucleotides on a substrate as claimed. Reconsideration and withdrawal of the anticipation rejection is respectfully requested.

Favorable and early action on this application is respectfully requested.

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### **SUMMARY AND CONCLUSIONS**

A complete listing of the claims is provided above. The pending claims in this application now include claims 3144-3147, 3150-3155, 3157-3169, 3172-3175, 3179-3183, 3185-3201, 3204-3209, 3211-3224, 3227-3232, 3234-3238, 3240-3248, 3252-3256, 3258-3268, 3271-3277, 3279-3283 and 3287-3407.

This paper (Amendment Under 37 C.F.R. §1.116) is being timely filed. Thus, no extension request or fee is necessary. No other fee or fees are believed to be due in connection with this paper. In the event that any other fee or fees are due, however, The Patent and Trademark Office is hereby authorized to charge the amount of any such fee(s) to Deposit Account No. 05-1135, or to credit any overpayment thereto.

If a telephone conversation would further the prosecution of the present application, Applicants' undersigned attorney request that he be contacted at the number provided below.

Respectfully submitted,



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